

## **II. RESPONSE TO OFFICE ACTION**

### **A. Status of the Claims**

Applicants have cancelled claims 1-53, 55-82, and 86-90, without prejudice or disclaimer.

Claims 54 and 83-85 were deemed allowable in the Office Action mailed September 1, 2004. Action at page 14. Consequently, claims 91-183 have been added as dependent claims from these allowable claims. With the exception of claims 95 and 141, the added claims correspond to the cancelled claims, and thus, these added claims have already been examined. The added claims were previously dependent from other rejected claims and essentially made dependent on each of the allowable claims 54 and 83 or 84. The following table indicates the previously presented claim from which the new claims were derived. Claims 95 and 141 merely incorporates limitations from two dependent claims previously presented. This is indicated in the table as well.

Because claims 54 and 83-85 were deemed free from the prior art, any dependent claims should also be free from the prior art. Moreover, the subject matter of these added claims was previously examined and therefore, essentially presents no new matter or issues to be addressed at this point, because the only previous rejections of these dependent claims were art rejections (claims 2-46, 48-53 and 86-90 were rejected under 112, second paragraph, because they were dependent from claim 1, which was found to have a 112, second paragraph, defect). Thus, because the new claims were generally examined and because the claims from which they depend are novel and nonobvious, the added dependent claims are also allowable.

Added Claim(s)	Former Claim
91 and 137	3
92 and 138	4
93 and 139	5
94 and 140	6
95 and 141	5 and 6
96 and 142	7
97 and 143	8
98 and 144	9
99 and 145	10
100 and 146	11
147	12
148	13
101 and 149	14
102 and 150	15
103 and 151	16
104 and 152	17
105 and 153	18
106 and 154	19
107 and 155	20
108 and 156	21
109 and 157	22
110 and 158	23
111 and 159	24
112 and 160	25

Added Claim(s)	Former Claim
113 and 161	26
114 and 162	27
115 and 163	28
116 and 164	29
117 and 165	30
118 and 166	31
119 and 167	32
120 and 168	33
121 and 169	34
122 and 170	35
123 and 171	36
124 and 172	37
125 and 173	38
126 and 174	39
127 and 175	40
128 and 176	42
129 and 177	46
130	48
131 and 178	53
132 and 179	86
133 and 180	87
134 and 181	88
135 and 182	89
136 and 183	90

#### **B. Incorporation by Reference**

The specification has been objected to for improper incorporation by reference. First Applicants note that none of the present claims has been rejected for enablement, written description or best mode, which are the requirements of § 112, first paragraph. Consequently, there is no need to consider the issue of incorporation of any reference.

Moreover, the references are properly incorporated by reference because throughout the specification, a context for what is being incorporated by reference is made. For example, at page 42, the paragraph with the incorporation by reference states:

Another non-limiting example is a "peptide nucleic acid", also known as a "PNA", "peptide-based nucleic acid analog" or "PENAM", described in U.S. Patent Serial Nos. 5,786,461, 5,891,625, 5,773,571, 5,766,855, 5,736,336, 5,719,262, 5,714,331, 5,539,082, and WO 92/20702, each of which is incorporated herein by reference.

Another example is provided at page 43:

Various different mechanisms of oligonucleotide synthesis have been disclosed in for example, U.S. Patents. 4,659,774, 4,816,571, 5,141,813, 5,264,566, 4,959,463, 5,428,148, 5,554,744, 5,574,146, 5,602,244, each of which is incorporated herein by reference.

It is clear that a context for what is being incorporated by reference is provided. This is true for the other references incorporated by reference. References listed in the Reference section are discussed in a context in the specification. Their relevance to the present application is indicated in the specification, and thus, it is clear what is being incorporated by reference into the application. Consequently, the incorporations in the application are proper. Applicants respectfully request this rejection be withdrawn.

### **C. Amendment to Specification**

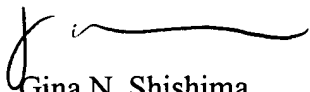
The specification has been amended to eliminate a hyperlink and replaced with comparable language.

### **CONCLUSION**

Applicants believe that the foregoing remarks fully respond to all outstanding matters for this application. Applicants respectfully request that the rejections of all claims be withdrawn because they are in condition for allowance. At the very least, Applicants request entry of these amendments in order to place the case in better form for an appeal.

Should the Examiner desire to sustain any of the rejections discussed in relation to this Response, the courtesy of a telephonic conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at 512-536-3081 is respectfully requested.

Respectfully submitted,



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Date: November 1, 2004